

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed December 24th, 2008.

In the Office Action, the Examiner rejected claims 1, 3, 6-13, 15, 18-26, 28, and 31-38 under 35 U.S.C. § 103.

Reconsideration in light of the remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 103

Claims 1, 3, 6-13, 15, 18-26, 28, and 31-38 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 6,637,029 issued to Maissel (hereinafter Maissel) in view of U.S. Patent No. 5,589,892 issued to Knee (hereinafter Knee) and even further in view of U.S. Patent No. 6,314,572 issued to LaRocca (hereinafter LaRocca).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In KSR International Co. vs. Teleflex, Inc., 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” The Court further required that an explicit analysis for this reason must be made. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 127 S.Ct. at 1741, quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006).

Further, as is well known in obviousness determinations, *impermissible hindsight must be avoided*. To prevent the use of hindsight based on the invention to defeat the patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. . . In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. (Emphasis added).

Applicant respectfully submits that there is no adequate teaching, suggestion, or motivation as set forth by the Examiner to make the 3-way combination of Maissel, Knee, and LaRocca and, thus, no *prima facie* case of obviousness has been adequately established, and further, even if Maissel, Knee, and LaRocca were properly combinable, their combination would not teach or suggest the limitations of independent claims 1, 13, and 26.

As will be described, there is no rational reasoning as set forth by the Examiner to combine Maissel, Knee, and LaRocca, except for *impermissible hindsight* to reconstruct Applicant's claims, which is improper. Maissel relates to "customization of an electronic program guide by an intelligent agent" (Maissel, col. 3, lines 1-2); Knee relates to an "electronic program schedule system with access to both stored television program schedule information and data feeds containing status information for live programs such as sporting events" (Knee, Abstract); and the LaRocca invention relates to: "...an interactive information distribution system such as a video-on-demand (VOD) system. . . More particularly, . . . a method and apparatus for providing subscription-on-demand (SOD) services, dependent subscription services and contingent service for such an interactive information distribution system." As will be described, Applicant respectfully submits that there is no rational reasoning set forth by the Examiner to combine these very different references related to electronic program guides and subscription-on-demand (SOD) services except for impermissible hindsight to reconstruct Applicant's claims.

Applicant is grateful that the Examiner acknowledged on page 2 of the Office Action that: "Neither of these citations [Maissel and Knee] in any way relate to accepting user input to select

the bundle of channels for subscription by a user.” However, the Examiner then, in hindsight, has brought in a third reference [the LaRocca reference] in an attempt to render obvious Applicant’s independent claims 1, 13, and 26.

Applicant respectfully submits that the Examiner has misinterpreted the teachings of Maissel, Knee, and LaRocca and that Maissel, Knee, and LaRocca do not teach or suggest the limitations of Applicant’s independent claims as set forth by the Examiner. Applicant will now address the Examiner’s misinterpretations of these references.

In particular, Applicant respectfully submits that Maissel, Knee, and LaRocca alone or in combination, do not teach or suggest anything relevant to Applicant’s claim limitations related to *recommending bundles of channels, subscription matrixes*, or any of the other particular limitations of Applicant’s claims.

On page 2 of the Office Action, in an attempt to address the Applicant’s previous argument that: “Applicant has reviewed column 18, lines 29-42 of Maissel and can find no teaching or suggestion of recommending at least one bundle of channels to the user based upon a subscription matrix for the user that is stored locally at the client terminal...”; the Examiner states that: “Maissel teaches recommending channels in an epg based on user’s preferences stored in a user profile...For example, referring to Fig. 9B, a select few News programs are highlighted indicated that the system is recommending those programs to the user...Maissel further teaches that user profile is stored locally and that the processing is performed locally...The profile information includes subscription information including information on television services to which a user is subscribed to...Hence, a subscription matrix which stored locally is certainly taught by Maissel (col. 14, lines 20-24 and lines 34-37).” (Office Action, page 2).

Even assuming, *arguendo*, that the Examiner’s interpretation of col. 14, lines 20-37 of Maissel as above was correct and that the Examiner’s reliance upon col. 18 lines 29-42 of Maissel (Office Action page 4) was correct (which Applicant believes they are not), Maissel still in no way teaches or suggests: *recommending at least one bundle of channels for subscriptions by the user based upon: a subscription matrix for the user that is stored locally at the client*

terminal...the currently selected program guide entry for the non-subscribed channel displayed in the program guide...and available bundles of channels for subscription...

As above, the Examiner relies on column 14, lines 20-24 and lines 34-37 of Maissel for allegedly teaching or suggesting *recommending bundles of channels to users and locally stored and locally processed subscription matrixes*. However, column 14, lines 20-24 and lines 34-37 of Maissel actually states that:

“...that other factors in addition to a viewer preference profile may also be applied by the intelligent agent 130. Examples of such other factors and their typical use by the intelligent agent 130 include the following:...subscription information, typically including information on televisions services which have been subscribed to by a viewer, may be used to eliminate programs not subscribed for from the program guide...”
(Emphasis added).

All of these “other factors” are utilized by the “the intelligent agent 130...to customize the program schedule information...” (Column 13, lines 34-36). Contrary to the Examiner’s assertion, Applicant respectfully submits that this citation of column 14 of Maissel merely relates to the fact that other factors may be utilized by the intelligent agent 130 for the presentation of an electronic program guide such as subscription information along with a variety of other information such as: parental control information, rating information, language choice information, as well as a plurality of others. Applicant respectfully submits that this section of Maissel in no way teaches or suggests *recommending bundles of channels to users and locally stored and locally processed subscription matrixes*.

Applicant respectfully submits that Examiner is selecting certain sections of Maissel to, in hindsight, re-create Applicant’s claims, which is impermissible. The Examiner must interpret the Maissel reference as a whole.

Contrary to the Examiner’s assertions, Maissel is related to a totally different invention than the invention set forth in Applicant’s independent claims 1, 13, and 26.

Looking particularly at Maissel, Maissel states that: “The present invention provides for customization of an electronic program guide by an intelligent agent. Typically, the intelligent

agent monitors viewing behavior of one viewer or a plurality of viewers and creates a preference profile based on the monitored viewing behavior. The intelligent agent then preferably employs the preference profile to customize the electronic program guide based on the preference profile.” (Col. 3, lines 1-7, emphasis added). In particular, the invention of Maissel relates to an intelligent agent for customizing program schedule information based on a viewer preference profile to produce a program guide including customized program schedule information and displaying the program guide. (Col. 3, lines 17-21, emphasis added).

Applicant respectfully submits that Maissel is related to an intelligent agent for customizing program schedule information and that Maissel is not related to, and in no way teaches or suggests, recommending bundles of channels based upon a subscription matrix that is stored locally at the client terminal.

Even more particularly, Applicant respectfully submits that, contrary to the Examiner’s assertion on page 4 of the Office Action, that column 18, lines 29-42 of Maissel in no way teaches or suggests *recommending at least one bundle of channels to a user based upon a subscription matrix* for the user that is stored locally at the client terminal.

Applicant has reviewed column 18, lines 29-42 of Maissel and can find no teaching or suggestion of recommending at least one bundle of channels to the user based upon a subscription matrix for the user that is stored locally at the client terminal. Instead, this section of Maissel relates to Figure 8A of Maissel which teaches a “head end 340 [that] comprises a head end intelligent agent 360 and a head end profile storage unit 370, which may be similar respectively to the intelligent agent 130 of FIG.1 and the profile storage unit 140 of FIG.1 respectively...” (Col. 18, lines 40-44). Even more particularly, the head end profile storage unit 370 as relied upon by the Examiner is further defined as being “typically operative to store viewer preference profiles for a wide variety of viewers located at a multiplicity of sites.” (Col. 18, lines 58-60).

As repeatedly defined in the detailed description of the Maissel patent, the intelligent agent is used to monitor the viewing behavior of a viewer or a plurality of viewers and to create a preference profile based on the monitored viewing behavior and the intelligent agent may then

employ the preference profile to customize the electronic program guide based on the preference profile.

Maissel quite clearly in no way teaches or suggests Applicant's claim limitations related to: *recommending at least one bundle of channels for subscription* by a user based upon a *subscription matrix* for the user that is stored locally at the client terminal, the currently selected program guide entry for the non-subscribed channel displayed on the program guide, and *available bundle of channels for subscription*, wherein the subscription matrix includes channels subscribed to by the client terminal and available channels not subscribed to by the client terminal.

As described in detail above, Maissel does not teach or suggest in any way, these claim limitations. In fact, the Examiner recognizes that Maissel fails to teach or suggest that upon a selection of a channel that is for a non-subscribed channel that the user is allowed to subscribe to that channel (Office Action, page 4). The Examiner cites Knee for this alleged teaching. As to Knee, Knee is directed to an electronic program schedule system with access to both stored television program schedule information and data feeds containing status information for live programs such as sporting events. (Abstract).

Applicant is grateful that the Examiner acknowledged on page 2 of the Office Action that: "Neither of these citations [Maissel and Knee] in any way relate to accepting user input to select the bundle of channels for subscription by a user." On page 5 of the Office Action the Examiner states: "...Maissel and Knee fail to disclose: ...accepting user input to select a bundle of channels for subscription by the user..." However, the Examiner then, in hindsight, has brought in a third reference [the LaRocca reference] in attempt to render obvious Applicants' independent claims 1, 13, and 26 and states that: "In an analogous art, LaRocca discloses accepting user input to select a bundle of channels for subscription by the user (col. 11, lines 44-65)".

LaRocca at col. 11, lines 44-65 states:

FIG. 8 depicts an exemplary screen 800 for interactively requesting a subscription-on-demand service, i.e., offers the subscriber an option to purchase a subscription. If the customer is required to purchase a premium cable channel to facilitate a dependent service, then the screen would offer the customer an opportunity to subscribe to the premium channel. If the subscriber declines (step 360) the subscription offer, the terminal then sends, at step 362, a refusal signal to the session manager. In response to the refusal, the process returns (step 364) to point C prior to step 316 in FIG. 3A. If, however, a system subscriber elects to purchase a subscription, the terminal sends, at step 366, an acceptance signal. In response to the acceptance signal, at step 368, the session manager requests a master PIN as a confirmation of the subscriber's capability to make a subscription purchase. As such, a person having only a subaccount PIN is not capable of subscribing to a subscription-on-demand service or a service that permits dependent services. To facilitate the subscription confirmation, the session manager sends an applet for a master PIN request screen. At step 370, the terminal decodes the applet and displays the master PIN request screen. (Emphasis added).

Thus, LaRocca allows a user to subscribe to a premium channel to obtain a dependent service. This is no way, alone or in combination with Maissel and Knee, teaches or suggests Applicant's limitations related to: "...upon the selection of a program guide entry that is for non-subscribed channel... *recommending at least one bundle of channels for subscription by the user based upon a subscription matrix for the user that is stored locally at the client terminal, the currently selected program guide entry for the non-subscribed channel displayed in the program guide, and available bundles of channels for subscriptions... wherein... the subscription matrix includes channels subscribed to by the client terminal and available channels not subscribed to by the client terminal... accepting user input to select a bundle of channels for subscription by the user... and... transmitting a subscription request for the selected bundle of channels to the video distribution system.*

Further, there is no rational reasoning as set forth by the Examiner to combine Maissel, Knee, and LaRocca, except for *impermissible hindsight* to reconstruct Applicant's claims, which is improper. Maissel relates to "customization of an electronic program guide by an intelligent agent" (Maissel, col. 3, lines 1-2); Knee relates to an "electronic program schedule system with access to both stored television program schedule information and data feeds containing status information for live programs such as sporting events" (Knee, Abstract); and the LaRocca

invention relates to: "...an interactive information distribution system such as a video-on-demand (VOD) system...More particularly,...a method and apparatus for providing subscription-on-demand (SOD) services, dependent subscription services and contingent services for such an interactive information distribution system." Applicant respectfully submits that there is no rational reasoning set forth by the Examiner to combine these very different references related to electronic program guides and subscription-on-demand (SOD) services except for impermissible hindsight to reconstruct Applicant's claims.

Applicant respectfully submits that Maissel, Knee, and LaRocca, either alone or in combination, do not expressly or implicitly teach or suggest the limitations of Applicant's independent claims 1, 13, and 26. Further, as previously discussed, Maissel, Knee, and LaRocca are not properly combinable.

Therefore, Applicant respectfully submit that independent claims 1, 13, and 26, and the claims that depend therefrom, are distinguishable over the prior art references and Applicant respectfully requests that these claims be allowed and passed to issuance.

Conclusion

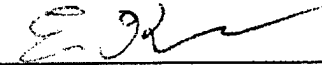
In view of the remarks made above, it is respectfully submitted that pending claims 1, 3, 6-13, 15, 18-26, 28, and 31-38 are allowable over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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By



Eric T. King

Reg. No. 44,188

Tel.: (714) 557-3800 (Pacific Coast)

Attachments

1279 Oakmead Parkway,
Sunnyvale, CA 94085-4040